

Art Unit: 1656

This Office action is in response to Applicants' remarks received August 2, 2009.

Applicants' arguments have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous Office actions are hereby withdrawn.

Claims 16-20 are withdrawn. The status identifiers of claims 16-20 should be corrected from (original) to (withdrawn). Claims 1-15 are currently under examination.

Claims 1-15 were discussed in a telephonic interview with Applicants' representative, Dr. Gudrun Hockett, on December 1, 2009, to discuss allowable subject matter and proposed amendments that may place the claims in condition for allowance. It was noted that the only issues believed to be remaining in the claims are under 35 U.S.C. 112, first and second paragraph. Amendments to claim 1 were proposed by Applicants' representative based on said telephonic interview; however, an agreement with regards to the claims was not reached. Therefore, claims 1-15 are unpatentable for the reasons noted herein.

Priority: The request for priority to GERMANY 102 41 681.8, filed September 9, 2002, is acknowledged. An english translation of the german application was filed August 2, 2009.

### **Objections and Rejections**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1656

Claims 1-2, 4-5, 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-2, 4-5, 7 are rejected under 35 U.S.C. 112, first paragraph, because it refers to a protein only by function.

The court of Appeals for the Federal Circuit has recently held that such a general definition does not meet the requirements of 35 U.S.C. 112, first paragraph. “A written description of an invention involving chemical genus, like a description of a chemical species, requires a precise definition, such as be structure, formula {or} chemical name, of the claimed subject matter sufficient to distinguish it from other materials.” *University of California v. Eli Lilly and Co.*, 1997 U.S. App. LEXIS 18221, at \*23, quoting *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). The court held that “in claims involving chemical materials, generic formulae usually indicate with specificity what generic claims encompass. One skilled in the art can distinguish such a formula from others and can identify many of the species that the claims encompass. Accordingly, such a formula is normally an adequate description of the claimed genus. In claims to genetic material, however, a generic statement such as “vertebrate insulin cDNA” or “mammalian insulin cDNA,” without more, is not an adequate written description of the genus because it does not distinguish it from others. One skilled in the art therefore cannot, as one can do with a fully described genus visualize the identity of the members of the genus”.

Art Unit: 1656

Here, Applicants are claiming a product by what it does (i.e. has a reversible, anisotropic contractability) rather than by what it is (i.e. in terms of structure). Appropriate correction is requested.

In the telephonic interview of December 1, 2009, it was suggested that the limitation of claim 3 be incorporated into claim 1 such that there is some structural information provided for the forisome that is recited in claim 1.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and its dependent claims are drawn to a protein body (forisome) isolated from Fabaceae, wherein the protein body has a reversible, anisotropic contractability and the physical characteristics recited in claim 1. Claim 1 recites "protein body." The specification discloses that "protein bodies" are also referred to as crystalline P-proteins (p. 1-2). Since it is unclear what specifically is meant by a "protein body" (i.e. all proteins would be believed to have a "body"), it is suggested that "protein body" be amended to "crystalline P-proteins" or "crystalloid proteins". Further, claim 1 currently recites only physical characteristics of the protein body. It is suggested that some structural information be provided for said protein body, i.e. incorporating the limitation of claim 3 into claim 1.

Art Unit: 1656

Claim 2 recites the protein body comprises a first protein and a second protein. The claim is dependent on claim 1, which currently does not recite that a first protein and a second protein are present. It is suggested that this limitation be incorporated into claim 1.

Claims 3, 6, 8-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-15 appear to be free of art.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marsha M. Tsay whose telephone number is (571)272-2938. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1656

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Maryam Monshipouri/

Primary Examiner, Art Unit 1656

December 11, 2009

Marsha Tsay  
Art Unit 1656